Remarks/Arguments

Claims 1-60 are pending in the application. Claims 61-63 are withdrawn from consideration, as deemed drawn to an unelected species. Claims 1-60 are rejected as anticipated by the Pricegrabber reference. Applicant respectfully submits that in view of the following remarks and arguments, all grounds of rejection are traversed and reconsideration is respectfully requested.

Applicant first respectfully notes that it generally stands by its prior response as clearly pointing out patentable distinctions between the claims and the cited prior art. Applicant will focus this response on addressing just some patentable distinctions.

Claims 1, 20, 22, 45, 48-49, and 53-54 stand rejected based on Pricegrabber. Each of these claims is an independent claim, and all are rejected based on characterizations of Pricegrabber in ¶¶ 3a-3b of the Action or in the "Response to the Arguments," ¶¶ 14-16.

Independent Claim 1 recites:

> 1. A method for generating annotation instructions in a system comprising a content provider computer system, a central computer system, and a client computer system, the method comprising: in an electronic content document retrievable from a content provider computer system storing content documents, embedding code executable by a client computer to invoke the central computer system to recognize key elements based on key elements contained in a key-element list; recognizing key elements in the document based on the key elements in the key-element list; and generating annotation instructions for the client computer system to create one or more annotations for one or more key elements in the content document and sending the instructions to the client computer system.

The Action considers the recited interplay of a client computer, content provider computer, and central computer to be indicated on page 4, ¶ D of Pricegrabber. The Action designates the central computer system as the Pricegrabber.com system and alleged retailer

computer systems as the content provider system. (Action, ¶ 15.) Page 4, ¶ D of Pricegrabber reads as follows:

> **Comparison Shopping**: If you already have a specific product in mind and would like to purchase that exact item, you can use PriceGrabber's comparative engine technology to guide you to the retailer with the best price. For example, if you are interested in a purchasing an Epson Stylus Color 440. You can type "Stylus Color 440" in the search window on our home page. PriceGrabber will then show all the products related to the Stylus Color 440 such as the printer, the cartridge or any other 440 related products offered through retailers. Each product will have a price and a wholesale price associated with it. The Price indicates the best price that PriceGrabber has identified for the particular product. The wholesale Price is provided as a point of reference so you can easily qualify and quantify a deal. The difference is also calculated and provided. A positive number indicates your percentage saving below what is believed to be the wholesale price. A negative percentage value is the premium that you are paying.

The Action specifically asserts that this paragraph teaches "getting information from retailers to present to users", and "retrieving information from retailers and that Pricegrabber merely supplies the connection and information but does not sell the products." (Action, ¶¶ 15-16.)

However, no claim under rejection recites "getting information from retailers [content provider]" or merely "retrieving information". Claim 1, for example, recites "an electronic content document retrievable from a content provider computer system. **Now that the Action designates the Pricegrabber.com system as the central computer system, and the retailer system as the content provider computer system, there is a framework for a principled claims evaluation.** What would correspond to the claim limitation, in the context of Pricegrabber.com's system would be retrieval by Pricegrabber.com of a content document from the retailer's computer system. This is not taught on page 4, ¶ D of Pricegrabber, or anywhere else in Pricegrabber.

Claim 1 further recites "embedding code executable by a client computer to invoke the central computer system to recognize key elements...." **In the context of Pricegrabber.com, this would mean that code is placed into the retailer's content page so that when it is**

rendered by the client system, it invokes the Pricegrabber.com system to recognize key elements. First, there is no teaching in Pricegrabber that content pages of the retailer are retrieved or modified. It is well known in the art that data from a web page, for example, can be extracted by software agents without copying the full web page. In other cases, XML feed may provide data apart from a content document. The most that could possibly be assumed, and even this is speculation insufficient to support a rejection, is that merely product and pricing data are extracted and uploaded to a database, without any structure that matches the content page from which the data were extracted. Second, the Office Action asserts that the user's search query is a key element and that the subsequent search and that the returned search results generated by Pricegrabber.com represent this limitation. This is backwards from what the claim recites (see prior response, page 15, last paragraph), and clearly it is not a modified retailer's content page that invokes anything.

Independent Claim 20 recites, with emphasis added:

> 20. A method for sending annotation instructions in a system comprising at least two computer systems, the method comprising:
>
> **on a first computer system, receiving over a packet-switched network a web page, the web page corresponding to a web page presented to the user of a second computer system;**
>
> **on the first computer system, recognizing** in the web page one or more predetermined key elements based on a key-element list, the key element list comprising one or more words relating to one or more products; and
>
> **sending annotation instructions from the first computer system to the second computer system for use in creating annotations on the web page presented on the second computer.**

The rejection of claim 20 is stated in ¶¶ 3a-b of the Action. The rejection does not mention first or second computers or any correspondence of web pages. Therefore, there is no prima facie anticipation because it has not been shown that Pricegrabber teaches the recited

limitations: "**on a first computer system, receiving over a packet-switched network a web page, the web page corresponding to a web page presented to the user of a second computer system**". The Action simply says that there is a web document of a provider and a search engine that does matching and annotation. But the web document on pages 2 and 45 are generated by Pricegrabber.com; they do not correspond to anything that was on the consumer computer system and **received** by Pricegrabber.com. Since there is no teaching of any such web page being received, it follows that Pricegrabber cannot and does not teach the claimed recognition of key elements on such page or that there is any sending of annotation instructions for such page. Accordingly, for any one or more of the foregoing reasons, claim 20 and its dependent claim 21 patentably distinguish over Pricegrabber.

Independent Claim 22 recites, with emphasis added:

> 22. A method comprising **sending a key list from a remote computer system** to a client computer system, **the client computer having executable code for performing one or both of annotation and recognition of key elements on the key list**, the key list comprising a set of **key elements** and **corresponding identifiers**; and the key list being adapted for the client computer to use in performing on an **electronic document presented to a user of the computer system from a content provider computer system** one or more of (i) **recognizing key elements** and (ii) **annotating key elements.**

The rejection of claim 22 is also stated in ¶ ¶ 3a-b of the Action. The rejection does not mention remote or client computers or any interrelationship concerning annotation/recognition of an electronic document from a content provider using a key list. In particular, the asserted web document is generated by Pricegrabber.com, not a third party content provider. Accordingly, there can be no disclosure of a consumer computer system receiving any instructions for annotation or recognition of such a content document from a content provider (bearing in mind that Pricegrabber.com cannot be both the sender of the key list and the content provider). Therefore, there is no prima facie anticipation because it has not been shown that Pricegrabber

teaches the recited limitations: **"the key list being adapted for the client computer [consumer] to use in performing on an electronic document presented to a user of the computer system from a content provider computer system one or more of (I) recognizing key elements and (ii) annotating key elements.** For any of the foregoing reasons, Claim 22 and dependent claims 23-26 patentably distinguish over Pricegrabber.

Independent Claim 27 recites, with emphasis added:

> 27. A method in a system comprising at least a content provider computer system and a consumer computer system, the method comprising: **on a first computer system, receiving an electronic document with at least one predetermined key element; from a second computer system, knowing the identity of the electronic document** received on the first computer system, **sending instructions to the first computer system** for presenting to the user of the first computer system one or more hyperlinks related to a key element on the electronic document so the user may retrieve data or information related to the key element, the **key element being contained in a key-element list**, wherein the second computer system did not provide the electronic document received on the first computer system.

In the framework of the Pricegrabber.com system, the first computer system would be the consumer computer system, and the second computer system would be the Pricegrabber.com computer system. The Action asserts that page 25 of Pricegrabber teaches that the second computer system did not supply the electronic document received on the consumer computer system. The Action considers that the selection of a product on the page to generate "information" that is sent to the Pricegrabber.com system. (Action, ¶ 6.) The Action considers "information" to be synonymous with "web document". This is contrary to the ordinary meaning of the word:

> A **document** contains information. It often refers to an actual product of writing and is usually intended to communicate or store collections of data. Documents are often the focus and concern of administration.

> The term *document* may be applied to any discrete representation of meaning, but usually it refers to something physical like one or more printed pages, or to a "virtual" document in electronic (digital) format.
>
> Source–http://en.wikipedia.org/wiki/Document

Consistent with this definition is Applicant's specification, which states that a "web document generally means electronic documents that may be presented through conventional browser applications...." (Spec. p. 13, lines 16-18.) Accordingly, the asserted document is at best only a data or information component of a document, not a stand-alone document. It certainly does not represent anything that would be annotated and presented to a user, as contemplated by Applicant's specification. Therefore, for at least this reason, claim 27 and dependent claims 28-32 patentably distinguish over Pricegrabber.

Independent Claim 33 recites, with emphasis added:

> 33. A method in a system comprising at least two computer systems, the method comprising: from a first computer system, providing a second computer system a set of predetermined key elements and corresponding identifiers for use in creating annotations for key elements on an electronic document, **the annotations are being made in addition to those that may be native to the original document, as renderably received by the first computer system;** receiving from the second computer system data associated with an annotation for a key element ("key element data") following selection of an annotation by a user of the second computer system, wherein the annotation was created by the second computer system using the key elements and corresponding identifiers provided by the first computer system; retrieving or generating data or information responsive to the key element data received from the second computer system; and sending the information to a computer system or output device associated with the user selecting the annotation.

The first computer in this set of claims would be the Pricegrabber.com computer system. The second computer system would be the consumer computer system. The Action asserts that page 26 of Pricegrabber discloses a set of predetermined key elements and corresponding identifiers (Action, ¶ 3F). At best page 26 shows terms that could be used on a key element list. Clearly, such terms are not seen to be associated with any corresponding identifier, and there is

no teaching of providing a set of key elements/identifiers from the Pricegrabber.com system. Applicant's specification teaches that identifiers represent an address (Spec., pp. 18-19 & Fig. 4). For at least this reason claim 33 and dependent claims 34- 42 are patentably distinct over Pricegrabber. Claims 45-47 and 53 have analogous limitations to claims 1 and 33 and are patentably distinct for the same reasons. (Claim 45 is amended to correct a typo.)

In any event, to emphasize the nature of the claimed invention, claim 33 has been amended to add the language shown in underlining. Clearly, Pricegrabber does not teach how to annotate a document independent of the HTML instructions that are native in a web document, causing the document to be rendered on a user's computer. Only these native instructions are disclosed in Pricegrabber. That the claimed inventions add annotations to a document, in addition to any preexisting native annotations, is evident from the teachings of the parsing operation and other recognition/annotation steps described on pages 18-30 of Applicant's specification. Support for the amendment is also found, for example, in Applicant's specification, page 22, lines 10-13, which explains how the annotations may be distinguished from those that may be native to the original, renderable document.

Claims 48, 49 (and dependent claims 50-52), and 54 (and dependent claims 55-59), have been amended in the same manner and are patentably distinct for at least these reasons, as well as the separate reasons that have been given with respect to other claims with which they have been grouped, namely claims 1, 20, and 22.

The Action had also asserted that the "Examiner is unable to determine which limitations of which claims Applicant believes are not anticipated by the prior art." (Action, ¶15.) Page 14-16 has a main heading and three sub-headings, and associated arguments, dealing with specific limitations of the independent claims. For example, page 14 of the prior response quotes claim 1 and highlights terms in that claim that are discussed in the ensuing three subheadings, each of which relates to specific limitations in claim. While Applicant does not

specifically relate those terms to claims 2-19 & 60, all of which are dependent from claim 1 as their base claim. It is axiomatic that if claim 1 is patentable the dependent claims thereto are patentable. Similarly, claim 48, another independent claim, recites a similar interplay of three computer systems using some of the same terms as distinguishing claim 1 over the prior art. There was no express application of prior art against this claim, and so it was grouped with the rejection of claim 1. Applicant requests reconsideration of the prior response and withdrawal of the finality of the Action if due consideration was not given to the prior response.

In view of the foregoing reasons that clearly distinguish the claims over the cited art, Applicant has not comprehensively stated every basis for overcoming the rejections of the Office Action. Applicant, however, reserves the right to do so at a later time. Therefore, nothing herein should be deemed as a disclaimer of any rights, an acquiescence in any rejection or a waiver of any arguments that might have been raised but were not raised herein or otherwise in the prosecution of this application.

(continued)

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CONCLUSION

Applicant submits that in view of the foregoing remarks and/or amendments, the application is in condition for allowance, and favorable action is respectfully requested.

The Commissioner is hereby authorized to charge any fees, including any extension fees, additional fees, or underpayments, or to credit any overpayments, to Deposit Account No. 50-1001.

Respectfully submitted,

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Date: 20 December 2006

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